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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,644	07/20/2001	Andrew S. Kanter	0010-2	1841

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EXAMINER	
CARLSON, JEFFREY D	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/909,644	KANTER, ANDREW S.	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the paper(s) filed 6/27/05.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 19 section E, there is no antecedent basis for the "matched advertisement."

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. **Claims 1, 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Landsman et al (US6687737).**

Regarding claim 1, Landsman et al teaches interstitial ads displayed to a user's browser from an Internet server. The ads are triggered based upon code in the web

page content [col 10 lines 5-31]. The ads are described as being displayed in browser popup windows which are shown to the user for a specified period of time (i.e. the duration of the ads) and the popup window is then removed upon completion. Landsman et al teaches that the AdDescriptor file specifies whether the user is permitted to prematurely terminate (close) the ad displayed [32:5-46, fig 20]. This is taken to provide a temporary, non-dismissible ad window. Landsman et al also teaches that a log is kept regarding each ad impression [31:53-58]. Landsman et al also teaches targeting ads based on stored user profiles [21:13-20] – this is taken to provide the registered user database and ad viewing history. When a user requests a subsequent webpage (via the user's ISP server(s)), the advertising display is triggered.

Regarding claims 5, 7, the ad display is programmed to be delayed until the user transitions to a subsequent page. Further, Landsman et al teaches ads that sleep for a predetermined time period before they are shown again [32:25-33].

Regarding claims 6, Landsman et al's plurality of ads to be shown and the ad queue are taken to provide a "series of ads" shown in an ad window.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 4, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al (US6687737).

Regarding claims 3, 4, Landsman et al teaches that the AdDescriptor file can specify the size and location of the ad window [fig 20]. It would have been obvious to one of ordinary skill at the time of the invention to have displayed the window anywhere including the top of the user's screen or the middle of the user's screen as a design choice so that the ad is quite visible. A pop-up ad displayed to a central portion of a user's screen can be said to be "within" the browser window that visually surrounds it.

Regarding claim 9, Official Notice is taken that it is well known for an advertiser to collect email/postal mailing addresses (demographic info) of interested prospective customer so that they can deliver more information about their products, services, sales promotions, etc. It would have been obvious to one of ordinary skill at the time of the invention to have provided buttons on the advertiser's site in order to request more information be sent to them and to have fulfilled such requests via an email. The optionally claimed links need not be taught by the prior art.

Claims 8, 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al (US6687737) in view of Goldhaber et al (US5855008).

Regarding claims 10, Landsman et al does not teach compensation. Goldhaber et al teaches many embodiments whereby a registered computer user is compensated for viewing advertising [abstract]. The advertising can be targeted based on the registered user's demographics. The compensation can be routed to the user's

registered account. It would have been obvious to one of ordinary skill at the time of the invention to have registered and compensated the ad-viewing users of Landsman et al's system so that users may be motivated to and may benefit from viewing online ads.

Regarding claim 8, it would have been obvious to one of ordinary skill at the time of the invention to have provided registration buttons and fillable forms/windows on the web site in order to collect registration information pursuant to Goldhaber et al's compensation. Goldhaber et al further discusses collection of personal (demographic) data at registration time.

Regarding claims 11, 15, 16, the ad display is programmed to be delayed until the user transitions to a subsequent page. Further, Landsman et al teaches ads that sleep for a predetermined time period before they are shown again [32:25-33].

Regarding claim 12, Landsman et al's plurality of ads to be shown and the ad queue are taken to provide a "series of ads" shown in an ad window.

Regarding claims 13, 14, Landsman et al teaches that the AdDescriptor file can specify the size and location of the ad window [fig 20]. It would have been obvious to one of ordinary skill at the time of the invention to have displayed the window anywhere including the top of the user's screen or the middle of the user's screen as a design choice so that the ad is quite visible. A pop-up ad displayed to a central portion of a user's screen can be said to be "within" the browser window that visually surrounds it.

Regarding claim 17, Landsman et al also teaches targeting ads based on stored user profiles [21:13-20].

Claims 2, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al (US6687737) in view of Goldhaber et al (US5855008) and Radziewicz et al (US5854897).

Regarding 2, 18, 19, Radziewicz et al also teaches interstitial ads. Radziewicz et al teaches that the user's connection speed to the Internet can be measured and such connection speed or the user's terminal capabilities (heavy video/graphics, audio) can be used to select a particular format for the ads [11:7-28]. It would have been obvious to one of ordinary skill at the time of the invention to have specified various ad formats in the AdDescriptor file so that the user can receive rich multimedia ads if their PC/connection could handle such files.

Regarding claim 20, Official Notice is taken that using a wireless connection in order to access the Internet is well known. It would have been obvious to one of ordinary skill at the time of the invention for wireless users to have participated in the system Landsman et al so that they can enjoy the Internet wirelessly.

Response to Arguments

6. Applicant's arguments filed 6/27/05 have been fully considered but they are not persuasive. Applicant argues that Landsman et al does not qualify under 102(e). Examiner disagrees and points out that the effective filing date(s) include 1/26/1999 and possibly 5/15/1998 depending on the subject matter supported.

7. Applicant argues that Landsman et al provides interstitial ads which are opened and closed responsive to the click-stream of the user and that the user can control the time period of ad display. Examiner disagrees and points again to column 32 lines 17-22 which states that the system displays an ad, waits a configurable amount of time (pre-specified in the AdDescriptor file) and terminates that ad visually upon completion. The option for a user to prematurely close the ad can be disabled by a setting in the AdDescriptor file, therefore resulting in an ad window that is non dismissible and temporarily visible for a predetermined amount of time. Column 32 lines 33-40 further describe programming that provides a popup ad which is displayed "for a pre-defined period of time" and "removes the pop up window."

8. Applicant argues that "for a predetermined time period" inherently is defined as a time period beyond the user's control. Examiner disagrees, yet notes that other claim language such as "non-dismissible" serves to provide a limitation describing limits to the user's ability to control the ad.

9. Applicant argues the Official Notice and requests evidence supporting a button to request more information via email. Examiner points to newly cited Gropper (US2005/0251448) which teaches a displayed banner, a user desiring more information and the ability to click the banner for initiating contact between the parties such as by telephone or email [para. 0035] and KOLLS (US2002/0077889) which teaches responses to ads to "see more detail" about the advertised item, visit the web site or

place a telephone call to the advertiser, requests a sales person contact the user or send an email [para. 0199]. The clicking of the ad is taken to be a button capable of being set to the ON state for initiating email contact.

10. Applicant argues that Goldhaber et al differs from the instant invention because the users of Goldhaber et al may elect to view the ads. Examiner is not using Goldhaber et al as a base reference, but rather Landsman et al which may be programmed to eliminate user control of the ads. Goldhaber et al is provided as a secondary teaching for compensation earned for viewing ads.

11. Applicant argues that extensive reconstruction would be required to provide the combination proposed. Examiner agrees that some reconstruction would be required but that it would be within the knowledge of one having ordinary skill in the art. Motivation for the combination is believed to be proper.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc